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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,727	08/30/2001	Kilian Dill	0405	1709
28869 7590 04/03/2008 COMBIMATRIX CORPORATION 6500 HARBOUR HEIGHTS PARKWAY MUKILTEO, WA 98275				
EXAMINER				
JUNG, UNSU				
ART UNIT		PAPER NUMBER		
1641				
MAIL DATE		DELIVERY MODE		
04/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/944,727

Applicant(s)

DILL, KILIAN

Examiner

Unsu Jung

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10, 13 and 16-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendments in the reply filed on December 21, 2007 have been acknowledged and entered. The reply included cancellation of claims 1-9, 11, 12, 14, and 15, amendments to claims 10, 13, and 16-18, and addition of new claim 19.

2. It is noted that applicant asserts that no new matter has been added. However, applicant does not direct support of new claim 19 in the original specification. Applicant is respectfully advised to direct support of new claim 19 in the original specification in the reply to this Office Action. Further, claim 19 appear to be in improper dependent form as the combination of target molecules being attached to the oxidation/reduction enzyme recited in claim 19 include entities (antigen) not included in the Markush group recited in independent claim 10. Applicant is further advised to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Election/Restrictions

3. Applicant's election without traverse of Group III (claims 10-13 and 15-18) in the reply filed on December 21, 2007 is acknowledged.

Applicant's election of species A (in situ synthesis with electrochemical techniques, claims 11 and 12) from List I and species A (oligonucleotides, claim 17) from List IV in the reply filed on December 21, 2007 is acknowledged. Because

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applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's election with traverse of species B (horseradish peroxidase, claim 13) from List II, species G (dextran, claim 16) from List III, and species C (single-stranded DNA, claim 18) from List V in the reply filed on December 21, 2007 is acknowledged. The traversal is on the ground(s) that the restriction of the species unduly narrows the scope of the invention and that the undue search burden does not exist. This is not found persuasive because the literature search for each species is distinct since the structural requirements of each species are different. While searches would be expected to overlap, there is no reason to expect the searches to be coextensive.

The requirement is still deemed proper and is therefore made FINAL.

4. Upon further consideration of the claims, the following supplemental species election is required.

Election/Restrictions

5. This application contains claims directed to the following patentably distinct species:

List: Oxidation/reduction enzyme and target molecule combination (claims 10, 13, and 16-19)

1. Antibody (claims 10, 13, and 16-18)
2. Anti-idiotypic antibody (claims 10, 13, and 16-18)
3. Biotin/streptavidin (claims 10, 13, and 16-18)
4. Biotin/avidin (claims 10, 13, and 16-18)

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5. Combinations thereof (for this species, applicant must select a specific combination of the above combinations, claims 10, 13, and 16-18)
6. First antibody/antigen/second antibody/streptavidin-biotin/oxidation/reduction enzyme (claim 19)
7. First antibody/antigen/second antibody/streptavidin-biotin/oxidation/reduction enzyme (claim 19)

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Unsu Jung whose telephone number is (571)272-8506. The examiner can normally be reached on M-F: 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Unsu Jung/
Unsu Jung, Ph.D.
Patent Examiner
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